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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/081,522    05/19/98    BROOKS    F    TSRI4190CONI

HM22/1010  
THE SCRIPPS RESEARCH INSTITUTE  
10550 NORTH TORREY PINES ROAD  
MAIL DROP TPC 8  
LA JOLLA CA 92037

EXAMINER
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GAMBEL, F

ART UNIT	PAPER NUMBER
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1644

12

DATE MAILED:

10/10/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/081522

Applicant(s)

BROOKS

Examiner

GSMDEL

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7/24/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 17-170 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 17-170 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Serial No. 09/081522  
Art Unit 1644

### DETAILED ACTION

1. Applicant's amendment/Election, filed 7/24/00 (Paper No. 11), is acknowledged.

Upon reconsideration of the pending claims and applicant's comments, including the distinction between the claimed methods; the following Restriction is set forth.

Prior to setting forth the restriction requirement, it is pointed out that the claims are drawn to patentably distinct methods. The method differ in etiologies and endpoints and require non-coextensive searches to such an extent that they are considered separately patentable. Therefore, the restriction will be set forth for each of the various groups, irrespective of the format of the claims.

Also, given applicant's comments concerning the distinction between the Inventions/Groups; applicant is invited to amend the claims (or to cancel and add new claims) to clearly set forth distinct Groups.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 17-23, 28-42, 64-84, 144-150, 155-170; drawn to methods of inhibiting tissue growth in solid tumors, classified in Class 424, subclasses 130.1 and 184.1.

II. Claims 17, 24-42, 105-145, 152-169; drawn to methods of inhibiting tissue growth in inflamed tissue, classified in Class 424, subclasses 130.1 and 184.1.

III. Claims 43-63; drawn to methods of inhibiting solid tumor tissue regression, classified in Class 424, subclasses 130.1 and 184.1.

IV. Claims 85-104; drawn to methods of inhibiting angiogenesis in a carcinoma, classified in Class 424, subclasses 130.1 and 184.1.

3. Inventions I/II/III/IV are different methods, which encompass different etiologies and endpoints and non-coextensive searches. Therefore, they are patentably distinct.

4. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-IV is not required for any other group from Groups I-IV and Groups I-IV have acquired a separate status in the art because the searches are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

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5. In addition to selecting a Group from above; this application contains claims directed to the following patentably distinct species of the claimed Groups I/II/III/IV: wherein the antagonist is:

- A) an  $\alpha v\beta 3$ -specific antibody or
- B) an RGD containing peptide.

These species are distinct because their structures and physicochemical properties differ to the extent that a person of ordinary skill in the art would not envision one in view of the other. Therefore, they are separate and patentably distinct species

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17, 43 and 85 are generic.

6. If Group II is elected from above; this application contains claims directed to the following patentably distinct species of the claimed Group II: wherein the inflammation/inflamed tissue (see page 14 of the specification) is:

- A) articular rheumatism,
- B) diabetic retinopathy,
- C) neovascular glaucoma,
- D) capillary proliferation in an atherosclerotic plaque,
- E) psoriasis, or
- F) osteoporosis.

These species are distinct because their etiologies and therapeutic endpoints differ. Therefore, they are separate and patentably distinct species

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17 is generic.

7. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.



Phillip Gambel, PhD.  
Primary Examiner  
Technology Center 1600  
October 5, 2000